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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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07/11/2003

Maria Cheek

AND/ 002

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04/14/2006

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EXAMINER

GREEN, BRIAN

ART UNIT

PAPER NUMBER

3611

DATE MAILED: 04/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/618,300	<b>Applicant(s)</b> CHEEK ET AL.	
	<b>Examiner</b> Brian K. Green	<b>Art Unit</b> 3611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,3-29 and 41-65 is/are pending in the application.
- 4a) Of the above claim(s) 8-10,16,21,22,49-51 and 58 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-7,11-15,17-20,23-29,41-48,52-57 and 59-65 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 8, 2006 has been entered.

### ***Election/Restrictions***

New claim 58 is drawn to a non-elected species and therefore has been withdrawn. New claim 58 is similar to claim 9 which was withdrawn in a previous office action as being directed to a non-elected species.

Claims 8-10,16,21,22,30-40,49,50,51, and 58 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim.

### ***Claim Objections***

Claim 17 is objected to because of the following informalities: In claim 17, lines 2-3, "second containment sheet" should be "second containment portion" to be consistent with claim 1. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

Claims 17,18,52, and 65 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 17 and 65, lines 3-4, it is not understood how the indicia can be included “in” the non-transparent portion. In claim 52, it is not clear how the non-transparent portion of the container can be a “non-transparent indicia”. The non-transparent portion includes indicia but it is not formed by non-transparent indicia as indicated by the applicant.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,11,15,19,20,24,25,41,44,53, and 59-62 are rejected under 35 U.S.C. 102(b) as being anticipated by Chabria (U.S. Patent No. 5,289,917).

In regard to claim 1, Chabria shows in figures 1-9 a greeting card comprising a first sheet segment (6), a second sheet segment (4), a first fold line (9), an aperture (adjacent the lead lines for numeral 13 in fig. 1) in the first sheet segment, a first transparent containment sheet (16), a second containment portion (5) attached to the containment sheet (16, see column 2, lines 33-35), and a substance (10) located in the special effects container. The second containment portion is non-transparent. In regard to claim 11, the second containment portion (5) is a third

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sheet segment of said folded sheet folded about a second fold line (one of the fold lines adjacent first containment sheet 6, see figure 1). In regard to claim 15, Chabria shows that the aperture is substantially non-circular. In regard to claim 19, the special effects container is considered to be operable to be opened in order to allow the flashlight (10) to be removed. In regard to claim 20, the container of Chabria is capable of performing the function of having the container re-sealed, i.e. re-gluing or taping the upper part of the container back to the panel (5). In regard to claim 24, Chabria shows a first and second sheet segment (4,6) folded about a first fold line (9), a special effects container (16,5) comprising a substantially flat sheet (5), and a substance (10) housed in the container. A portion of the container is transparent (16) and another portion is non-transparent (5). In regard to claim 25, as broadly defined, the flashlight (10) is considered to be the special effects particles, i.e. the housing, light bulb, and batteries are considered to create special effects. In regard to claim 41, Chabria shows a first sheet segment (5), a second sheet segment (6) including an aperture (adjacent the lead lines for numeral 13, fig. 1), a third sheet segment (4), a transparent containment sheet (16) affixed to the second sheet segment and the first and second sheet segments (5,6) are affixed together to form a container. In regard to claim 44, the substance is considered element (10). In regard to claim 53, Chabria shows in figures 1-9 a first sheet segment (6) and second sheet segment (4), a fold line (9), a first containment sheet (16), a second containment sheet (5), and a substance (10) within the container formed by the first containment sheet and the second containment sheet. In regard to claim 59, the second containment sheet (5) is folded about a second fold line (one of the fold lines adjacent panel (6) in figure 1. In regard to claim 60, the first, second, and third sheet segments are non-transparent.

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In regard to claim 61, the third sheet segment includes no aperture. In regard to claim 62, the second sheet portion is non-transparent.

Claims 1,11,15,19,20,24,25,41,44,53, and 59-62 are rejected under 35 U.S.C. 102(b) as being anticipated by Boone (U.S. Patent No. 4,870,764).

In regard to claim 1, Boone shows in the figure a greeting card comprising a first sheet segment (2), a second sheet segment (3), a first fold line (the fold line between the first and second sheet segments), an aperture (4) in the first sheet segment, a first transparent containment sheet (6), a second containment portion (11 or 15 or 11 and 15) attached to the containment sheet (6), and a substance (9,12) located in the special effects container. The second containment portion (11) is non-transparent. In regard to claim 11, the second containment portion (11) is a third sheet segment of said folded sheet folded about a second fold line (the fold line between panel 2 and panel 11). In regard to claim 15, Boone shows that the aperture is substantially non-circular. In regard to claim 19, the special effects container is considered to be operable to be opened in order to allow the contents (9,12) to be removed. In regard to claim 20, the container of Boone is capable of performing the function of having the container re-sealed, i.e. gluing or securing the containment panel (11) back to the panel (2). In regard to claim 24, Boone shows a first and second sheet segment (2,3) folded about a first fold line, a special effects container (6,15,11) comprising a substantially flat sheet (11 or 15), and a substance (9,12) housed in the container. A portion of the container is transparent (7) and another portion is non-transparent (11 or 15). In regard to claim 25, as broadly defined, the elements (9,12) are considered to be the special effects particles. In regard to claim 41, Boone shows a first sheet segment (15 or 11 or

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15 and 11), a second sheet segment (2) including an aperture (4), a third sheet segment (3), a transparent containment sheet (6) affixed to the second sheet segment and the first and second sheet segments (2,15 or 11 or 15 and 11) are affixed together to form a container. In regard to claim 44, the substance is considered element (9,12). In regard to claim 53, Boone shows in the figure a first sheet segment (2) and second sheet segment (3), a fold line (the fold line between 2 and 3), a first containment sheet (6), a second containment sheet (11 or 15 or 11 and 15), and a substance (9,12) within the container formed by the first containment sheet and the second containment sheet. In regard to claim 59, the second containment sheet (11) is folded about a second fold line. In regard to claim 60, the first, second, and third sheet segments are non-transparent. In regard to claim 61, the third sheet segment includes no aperture. In regard to claim 62, the second sheet portion is non-transparent.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3,14, and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chabria (U.S. Patent No. 5,289,917).

In regard to claims 3 and 54, Chabria does not disclose attaching the first containment sheet on one side of the first sheet segment and the second containment sheet to the other side of the

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first sheet segment. Chabria shows in figure 5 the idea of attaching the first and second containment sheets to the same side of the first sheet segment. It would have been an obvious matter of design choice to attach the containment sheets to opposite sides of the first sheet segment since the applicant fails to provide any advantage to attaching the containment sheets on opposite sides of the first sheet segment and attaching the containment sheets on the same side as disclosed by Chabria would work equally as well. In regard to claim 14, Chabria does not disclose making the aperture circular. Chabria shows in the figures the idea of making the aperture rectangular. It would have been an obvious matter of design choice to make the aperture circular since the applicant fails to define any advantage to making the aperture round and the shape taught by Chabria would work equally well.

Claims 17,18,52, and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chabria (U.S. Patent No. 5,289,917) in view of Saito (U.S. Patent No. 5,607,101).

Chabria discloses the applicant's basic inventive concept except for placing indicia on the second containment sheet. Saito shows in figures 1a-1c the idea of placing indicia (17) on a second containment sheet in order to create a more amusing and aesthetically pleasing display. In view of the teachings of Saito it would have been obvious to one in the art to modify Chabria by placing indicia on the second containment sheet since this would create a more amusing and aesthetically pleasing display device. In regard to claim 18, Chabria in view of Saito do not disclose making the indicia in the form of a snowman. It is considered within one skilled in the art to make the indicia in any form as desired. The indicia defined by the applicant is not



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functionally related to the substrate and therefore does not distinguish the invention from the prior art. See *In re Gulack*, 703 F.2d 1381, 217 USPQ 401 (Fed. Cir. 1983).

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chabria (U.S. Patent No. 5,289,917) in view of Fine et al. (U.S. Patent No. 6,438,878) or Gregory-Gillman (U.S. Patent No. 6,151,823).

Chabria does not disclose the idea of tinting the first containment sheet. Fine et al. shows a display device in which the walls (140,150) are tinted with a color, see column 5, lines 38-42. Gregory-Gillman discloses the use of a pocketed display device that includes a tinted front wall, see column 7, lines 28-36. In view of the teachings of Fine et al. or Gregory-Gillman it would have been obvious to one in the art to modify Chabria by tinting the first containment sheet since this would create a more amusing and aesthetically pleasing display and would help to protect the substance within the container from being damaged by the sun.

Claims 3,14, and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boone (U.S. Patent No. 4,870,764).

In regard to claims 3 and 54, Boone does not disclose attaching the first containment sheet on one side of the first sheet segment and the second containment sheet to the other side of the first sheet segment. Boone shows in the figure the idea of attaching the first and second containment sheets to the same side of the first sheet segment. It would have been an obvious matter of design choice to attach the containment sheets to opposite sides of the first sheet segment since the applicant fails to provide any advantage to attaching the containment sheets on opposite sides

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of the first sheet segment and attaching the containment sheets on the same side as disclosed by Boone would work equally as well. In regard to claim 14, Boone does not disclose making the aperture circular. Boone shows in the figures the idea of making the aperture generally rectangular. It would have been an obvious matter of design choice to make the aperture circular since the applicant fails to define any advantage to making the aperture round and the shape taught by Boone would work equally well.

Claims 17,18,42,43,52, and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boone (U.S. Patent No. 4,870,764) in view of Saito (U.S. Patent No. 5,607,101).

Boone discloses the applicant's basic inventive concept except for placing indicia on the second containment sheet. Saito shows in figures 1a-1c the idea of placing indicia (17) on a second containment sheet in order to create a more amusing and aesthetically pleasing display. In view of the teachings of Saito it would have been obvious to one in the art to modify Boone by placing indicia on the second containment sheet since this would create a more amusing and aesthetically pleasing display device. In regard to claim 18, Boone in view of Saito do not disclose making the indicia in the form of a snowman. It is considered within one skilled in the art to make the indicia in any form as desired. The indicia defined by the applicant is not functionally related to the substrate and therefore does not distinguish the invention from the prior art. See *In re Gulack*, 703 F.2d 1381, 217 USPQ 401 (Fed. Cir. 1983). In regard to claims 42 and 43, Boone does not disclose whether the second sheet segment (11 or 15 or 11 and 15) are affixed together around the perimeter of the second sheet segment or around the perimeter of the aperture. Saito shows in figures 1a-1c the idea of attaching together first and second segments

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(11,12) together around the perimeters of the second segment and the aperture (15). In view of the teachings of Saito it would have been obvious to one in the art to modify Saito by attaching the first and second sheet segments together around the perimeter of the second segment and aperture since this would allow the segments to be attached together in a more secure manner which would help to prevent the container portion (6) from falling out accidentally.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Boone (U.S. Patent No. 4,870,764) in view of Fine et al. (U.S. Patent No. 6,438,878) or Gregory-Gillman (U.S. Patent No. 6,151,823).

Boone does not disclose the idea of tinting the first containment sheet. Fine et al. shows a display device in which the walls (140,150) are tinted with a color, see column 5, lines 38-42. Gregory-Gillman discloses the use of a pocketed display device that includes a tinted front wall, see column 7, lines 28-36. In view of the teachings of Fine et al. or Gregory-Gillman it would have been obvious to one in the art to modify Boone by tinting the first containment sheet since this would create a more amusing and aesthetically pleasing display and would help to protect the substance within the container from being damaged by the sun.

Claims 4-7,12-13,26-29,45-48,55-57,63, and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boone (U.S. Patent No. 4,870,764) in view of Hirsch (U.S. Patent No. 6,484,425).

In regard to claims 4,29,45, and 55, Boone does not disclose the idea of making the substance within the container in the form of glitter. Hirsch shows in figures 1-4 a display that includes an

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aperture in a sheet which receives a transparent container (11) which includes a liquid and particles therein. Hirsch discloses in column 4, lines 15-20 that the particles can be glitter. In view of the teachings of Hirsch it would have been obvious to one in the art to modify Boone by making the substance in the container in the form of glitter since this would create a more amusing and aesthetically pleasing display. In regard to claims 5 and 46, Boone does not disclose the idea of making the substance within the container in the form of confetti. Hirsch shows in figures 1-4 a display that includes an aperture in a sheet which receives a transparent container (11) which includes a liquid and plurality of particles therein. Hirsch discloses in column 4, lines 15-20 that the particles can be glitter, colored plastic, pellets, chips, etc. The use of confetti is well known in the art. In view of the teachings of Hirsch and the fact that confetti is conventional in the art it would have been obvious to one in the art to modify Boone by making the substance in the container in the form of confetti since this would create a more amusing and aesthetically pleasing display. In regard to claims 6,7,12,13,26,27,47,48,56,57,63, and 64, Boone does not disclose the idea of placing liquid in the container and the idea of placing particles within the liquid. Hirsch shows in figures 1-4 a display that includes an aperture in a sheet which receives a transparent container (11) which includes a liquid and particles therein. Hirsch discloses in column 4, lines 15-20 that the particles can be glitter, plastic strips, colored plastic, sponge, rubber, metal, beans, pellets, etc. In regard to claims 6,26,47, and 56, in view of the teachings of Hirsch it would have been obvious to one in the art to modify Boone by placing a liquid within the container since this would create a more amusing and aesthetically pleasing display. In regard to claims 7,12,13,27,48,57,63, and 64, in view of the teachings of Hirsch it would have been obvious to one in the art to modify Boone by placing a liquid having particles

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within the container since this would create a more amusing and aesthetically pleasing display.

In regard to claims 12,13,63, and 64, Hirsch discloses the use of both floating and sinking particles, see column 4, lines 15-25.

Claims 5,28,46, and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boone (U.S. Patent No. 4,870,764) in view of Borden (U.S. Patent No. 5,197,213).

Boone does not disclose the idea of making the substance within the container in the form of confetti. Borden shows in figures 1-4 a display that includes a transparent holder that includes confetti therein, see column 5, lines 5-10. In view of the teachings of Borden it would have been obvious to one in the art to modify Boone by making the substance in the container in the form of confetti since this would create a more amusing and aesthetically pleasing display.

### ***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian K. Green whose telephone number is (571) 272-6644. The examiner can normally be reached on M-F 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (571) 272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
BRIAN K. GREEN  
PRIMARY EXAMINER

Bkg  
April 12, 2006